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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
POKRZYWA, JOSEPH R	

ART UNIT	PAPER NUMBER
2622	15

DATE MAILED: 03/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/277,172	MAEDA, TORU	
	Examiner	Art Unit	
	Joseph R. Pokrzywa	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 December 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *66-68,70-74 and 89* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *66-68,70-74 and 89* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 November 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 12/18/03 has been entered.

Response to Amendment

2. Applicant's amendment received on 11/28/03 has been entered and made of record. Currently, **claims 66-68, 70-74, and 89** are pending.

Response to Arguments

3. Applicant's arguments with respect to **claims 66 and 89** have been considered but are moot in view of the new ground(s) of rejection.

Drawings

4. The drawings were received on 11/28/03. These drawings are acceptable by the examiner.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. **Claims 66-68, 70-72, and 89** are rejected under 35 U.S.C. 103(a) as being unpatentable over Merritt *et al.* (U.S. Patent Number 6,421,429, cited in the Office action dated 4/22/03) in view of Hochman (U.S. Patent Number 5,838,685).

Regarding ***claim 66***, Merritt discloses an image communication method that utilizes a plurality of Internet facsimile modes (column 5, lines 51 through 58) and a G3 facsimile mode (column 5, lines 58 through 65), with the method comprising the steps of detecting an Internet facsimile mode of a communication partner's apparatus during communication in the G3 facsimile mode, in accordance with a first procedure signal of the G3 facsimile mode (column 5, lines 51 through 65, and column 11, lines 16 through 36), and transmitting an image in the Internet facsimile mode of the communication partner's apparatus detected in the detecting step (column 11, lines 16 through 36), wherein the plurality of Internet facsimile modes comprise a simple mode (column 9, line 7 through column 10, line 24, being the desired "less than all the originating image data for certain types of data", and the mode having the "fastest transmission time at a minimum acceptable quality", and column 11, lines 37 through 42), a full mode (column 9, line 41 through column 10, line 43, specifically column 10, lines 25 through 34, with the mode having the sending party transmit an image in any of multiple formats to be received by multiple destinations that can support one or more of the file formats, thereby transmitting full

representation of the image data, as opposed to just the minimum amount of image data), and a real time mode (column 5, line 66 through column 6, line 17, and column 9, lines 7 through 65).

However, Merritt fails to specifically teach of *replacing an address of the Internet facsimile mode by utilizing a second procedure signal of the G3 facsimile mode*, and subsequently, transmitting an image in the Internet facsimile mode of the communication partner's apparatus detected in the detecting step *by utilizing a replacement address*. Hochman discloses an image communication method that utilizes a plurality of Internet facsimile modes (column 1, lines 11 through 50, and column 5, lines 16 through 65) and a G3 facsimile mode (column 5, lines 16 through 55, wherein handshake data that includes a TSI signal is inherently included within a G3 facsimile protocol), with the method comprising the steps of detecting an Internet facsimile mode of a communication partner's apparatus during communication in the G3 facsimile mode (column 4, lines 16 through 62, and column 5, lines 35 through 65), in accordance with a first procedure signal of the G3 facsimile mode (step 104 in Fig. 5, column 4, lines 16 through 62, and column 5, lines 38 through 41), replacing an address of the Internet facsimile mode by utilizing a second procedure signal of the G3 facsimile mode (step 106 in Fig. 5, column 5, lines 5 through 62), and transmitting an image in the Internet facsimile mode of the communication partner's apparatus detected in the detecting step by utilizing a replacement address (step 112 in Fig. 5, column 5, line 44 through column 6, line 5). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teachings of Hochman in the system of Merritt. Merritt's system would easily be modified to include Hochman's teachings, as the systems share cumulative features, being additive in nature.

Regarding ***claim 67***, Merritt and Hochman disclose the method discussed above in claim 66, and Merritt further teaches that the detected Internet facsimile mode of the communication partner's apparatus is stored (column 4, lines 15 through 46, and column 11, lines 16 through 36), wherein image data is transmitted in accordance with the stored Internet facsimile mode of the communication partner's apparatus (column 4, line 21 through column 5, line 12).

Regarding ***claim 68***, Merritt and Hochman disclose the method discussed above in claim 67, and Merritt further teaches of the step of determining whether or not the communication is a first communication operation in the Internet facsimile mode with the communication partner's apparatus (column 11, lines 16 through 36), wherein image data is transmitted in the G3 facsimile mode in a first communication operation (column 5, lines 58 through 65, and column 8, lines 5 through 35), based on a determination that the communication with the communication partner's apparatus is the first communication operation in the Internet facsimile mode (column 8, lines 5 through 35, and column 11, lines 16 through 36, being the communication from the sender), and wherein image data is transmitted in the Internet facsimile mode of the communication partner's apparatus (column 9, line 7 through column 10, line 24), based on a determination that the communication with the communication partner's apparatus is not a first communication operation in the Internet facsimile mode (column 4, line 21 through column 5, line 32, and column 8, lines 25 through 35, being the communication to the destination).

Regarding ***claim 70***, Merritt and Hochman disclose the method discussed above in claim 66, and Merritt further teaches that when shifting to the Internet facsimile mode, one of the simple mode, the full mode, and the real time mode is selected from among the plurality of Internet facsimile modes possessed by the communication partner's apparatus according to a

predetermined priority (column 5, line 66 through column 6, line 36, and column 10, lines 35 through 62), and communication in the selected Internet facsimile mode is performed (column 6, line 18 through 36, and column 10, lines 44 through 62).

Regarding ***claim 71***, Merritt and Hochman disclose the method discussed above in claim 70, and Merritt further teaches that the selection is performed in order of the real time mode, the full mode, and the simple mode (column 5, line 66 through column 6, line 17, column 9, line 66 through column 10, line 62, wherein the subscriber's can set which modes are defaults, and the capabilities they have, which would perform the selection in numerous orders, including real time, full, and simple modes).

Regarding ***claim 72***, Merritt and Hochman disclose the method discussed above in claim 70, and Merritt further teaches that when the simple mode or the full mode of Internet facsimile has been selected (column 7, lines 23 through 348), an Internet facsimile communication apparatus is caused to transmit an e-mail in which an image file formed in accordance with the selected mode is added (column 7, line 9 through column 8, line 4).

Regarding ***claim 89***, Merritt discloses an image communication apparatus that utilizes a plurality of Internet facsimile modes (column 5, lines 51 through 58) and a G3 facsimile mode (column 5, lines 58 through 65), with the apparatus comprising a detection unit adapted to detect an Internet facsimile mode of a communication partner's apparatus during communication in the G3 facsimile mode, in accordance with a first procedure signal of the G3 facsimile mode (column 5, lines 51 through 65, and column 11, lines 16 through 36), and a transmission unit adapted to transmit an image in the Internet facsimile mode of the communication partner's apparatus detected by the detection unit (column 11, lines 16 through 36), wherein the plurality

of Internet facsimile modes comprise a simple mode (column 9, line 7 through column 10, line 24, being the desired "less than all the originating image data for certain types of data", and the mode having the "fastest transmission time at a minimum acceptable quality", and column 11, lines 37 through 42), a full mode (column 9, line 41 through column 10, line 43, specifically column 10, lines 25 through 34, with the mode having the sending party transmit an image in any of multiple formats to be received by multiple destinations that can support one or more of the file formats, thereby transmitting full representation of the image data, as opposed to just the minimum amount of image data), and a real time mode (column 5, line 66 through column 6, line 17, and column 9, lines 7 through 65).

However, Merritt fails to specifically teach of *a replacement unit adapted to replace an address of the Internet facsimile mode by utilizing a second procedure signal of the G3 facsimile mode*, and subsequently, transmitting an image in the Internet facsimile mode of the communication partner's apparatus detected by the detection unit *by utilizing a replacement address*. Hochman discloses an image communication apparatus that utilizes a plurality of Internet facsimile modes (column 1, lines 11 through 50, and column 5, lines 16 through 65) and a G3 facsimile mode (column 5, lines 16 through 55, wherein handshake data that includes a TSI signal is inherently included within a G3 facsimile protocol), with the apparatus comprising a detection unit adapted to detect an Internet facsimile mode of a communication partner's apparatus during communication in the G3 facsimile mode (column 4, lines 16 through 62, and column 5, lines 35 through 65), in accordance with a first procedure signal of the G3 facsimile mode (step 104 in Fig. 5, column 4, lines 16 through 62, and column 5, lines 38 through 41), a replacement unit adapted to replace an address of the Internet facsimile mode by utilizing a

second procedure signal of the G3 facsimile mode (step 106 in Fig. 5, column 5, lines 5 through 62), and a transmission unit adapted to transmit an image in the Internet facsimile mode of the communication partner's apparatus detected by the detection unit by utilizing a replacement address (step 112 in Fig. 5, column 5, line 44 through column 6, line 5). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the teachings of Hochman in the system of Merritt. Merritt's system would easily be modified to include Hochman's teachings, as the systems share cumulative features, being additive in nature.

7. **Claim 73** are rejected under 35 U.S.C. 103(a) as being unpatentable over Merritt *et al.* (U.S. Patent Number 6,421,429, cited in the Office action dated 4/22/03) in view of Hochman (U.S. Patent Number 5,838,685), and further in view of Okutomi *et al.* (U.S. Patent Number 6,211,972, cited in the Office action dated 4/22/03).

Regarding ***claim 73***, Merritt and Hochman disclose the method discussed above in claim 72, and Hochman further teaches that an Internet address comprises an e-mail address (column 5, lines 16 through 65). However, both Merritt and Hochman fail to specifically teach if the image file comprises a TIFF file. Okutomi discloses a communication apparatus having an Internet facsimile communication means that comprises means for transmitting an E-mail (LAN controlling section 7, seen in Fig. 3, and column 3, lines 19 through 25), means for converting a read image into an image file (e-mail format converting means 8, column 3, lines 19 through 25), and an addition means for adding the image file to the E-mail (column 5, lines 31 through 43), and wherein the control means stores a signal received by the facsimile communication means in the storage means so as to correspond to an Internet facsimile address of the communication

partner's apparatus (column 3, lines 40 through 58), and causes the conversion means to convert the read image into the image file in accordance with the signal stored in the storage means, during image transmission by the Internet facsimile communication means (column 3, lines 49 through 63). Okutomi further teaches that the image file comprises a TIFF file (column 3, lines 59 through 63, and column 5, lines 31 through 43), and wherein an Internet address comprises an e-mail address (column 3, lines 33 through 63). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Okutomi's teachings in the system of Merritt and Hochman. Merritt and Hochman's system would easily be modified to include Okutomi's teachings, as the systems share cumulative features, being additive in nature.

8. **Claim 74** is rejected under 35 U.S.C. 103(a) as being unpatentable over Merritt *et al.* (U.S. Patent Number 6,421,429, cited in the Office action dated 4/22/03) in view of Hochman (U.S. Patent Number 5,838,685), further in view of Feder (U.S. Patent Number 5,872,845, cited in the Office action dated 4/22/03), and further in view of Kulakowski (WIPO Publication Number WO 97/10668, cited in the Office action dated 4/22/03).

Regarding ***claim 74***, Merritt and Hochman disclose the method discussed above in claim 70, and Merritt further teaches that the Internet facsimile communication means comprises means for transmitting packets to an Internet address (column 9, lines 31 through 65). However, Merritt fails to specifically teach of when the real time mode has been selected, an Internet facsimile communication apparatus is caused to convert a procedure signal and image data into TCP packets, transmit the TCP packets according to a T30 facsimile procedure, and convert TCP

packets received from the communication partner's apparatus into a T30 frame. Feder discloses a communication apparatus comprising means for detecting an Internet facsimile mode (column 1, lines 49 through 58) of a communication partner's apparatus during communication by G3 facsimile communication means (column 1, lines 49 through 58, column 6, lines 3 through 24, and column 7, lines 44 through 54), and means for performing control of causing the G3 facsimile communication means to disconnect communication in a G3 facsimile mode (see Fig. 8B, column 9, lines 1 through 13) and shifting to communication by Internet facsimile communication means (see Fig. 8B, "yes" determination of "long distance call", leading to process shown in Fig. 8C, column 8, lines 24 through 67), based on the detection of Internet facsimile mode of the communication partner's apparatus by the detection means (column 9, lines 14 through 32), wherein the plurality of Internet facsimile modes comprise a simple mode (column 7, lines 55 through 57), a full mode (column 5, lines 51 through 66), and a real time mode (column 7, lines 64 through 67). Feder further teaches that the Internet facsimile communication means comprises means for transmitting packets to an Internet address (column 8, lines 37 through 67, and column 9, lines 14 through 32), means for receiving packets (column 9, lines 33 through 65), means for converting a facsimile frame into packets (column 8, lines 24 through 67), and means for converting packets into a facsimile frame (column 9, line 53 through column 10, line 25), and wherein, when the real time mode has been selected (column 7, lines 64 through 67), the control means causes the Internet facsimile communication means to convert a procedure signal and image data into packets (column 8, lines 17 through 67), transmit the obtained packets according to a facsimile procedure (column 9, line 53 through column 10, line

25), and convert packets received from the communication partner's apparatus into a facsimile frame (column 9, line 65 through column 10, line 25).

However, Feder also fails to particularly teach of means for converting a T30 frame into TCP packets, and means for converting TCP packets into a T30 frame, and subsequently, transmit the obtained TCP packets according to a T30 facsimile procedure, and convert TCP packets received from the communication partner's apparatus into a T30 frame. Kulakowski discloses a communication apparatus having an Internet facsimile communication means comprises means for transmitting TCP packets to an Internet address (page 13, lines 11 through 36, and page 14, lines 20 through 36), means for receiving TCP packets (page 20, lines 24 through 30), means for converting a T30 frame into TCP packets (page 14, lines 20 through 36, and page 16, line 28 through page 17, line 19), and means for converting TCP packets into a T30 frame (page 20, line 27 through page 21, line 7), and wherein the control means causes the Internet facsimile communication means to convert a procedure signal and image data into TCP packets, transmit the obtained TCP packets according to a T30 facsimile procedure, and convert TCP packets received from the communication partner's apparatus into a T30 frame (see Figs. 5, 7, and 8). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Feder's teachings, modified with the teachings of Kulakowski, in the system of Merritt and Hochman. The system of Feder would easily be modified to include Kulakowski's teachings, therein conforming to standards well known within the art, as the systems share cumulative features, being additive in nature. Subsequently, Merritt and Hochman's system would easily be modified to include Feder and Kulakowski's teachings, as the systems all share cumulative features, being additive in nature.

Citation of Pertinent Prior Art

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Suzuki (U.S. Patent Number 6,005,677) discloses a system that detects an e-mail address in procedure signals of a G3 facsimile mode for a subsequent Internet facsimile mode.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrp